

11009-22.JVD.319544

IN THE DRAWINGS

Paragraphs one and two of the Office Action point out the need to correct FIGS. 1-5 and FIG. 8.

Corrected drawing sheets in compliance with 37 C.F.R. § 1.121(d) are provided with this response. Applicant provides amended replacement drawing sheets in both marked and clean versions. Removal of the objection to the drawings is respectfully requested.

11009-22,JVD319544

REMARKS

Reconsideration of the present application is respectfully requested.

Being submitted concurrently with this Amendment and Response by regular first class mail is a Supplemental Information Disclosure Statement.

Drawings.

FIGS. 1-5 were objected to for not including a legend such as "Prior Art." Further, FIG. 8 was objected to for an arrow that is in the wrong direction.

Applicant has corrected these errors and provided replacement sheets with this Response. Applicant requests withdrawal of the objection.

Priority Claim.

The Office Action states that Applicant improperly claims the benefit of a U.S. provisional patent application.

Applicant has revised the first paragraph of the specification to include a priority claim to U.S. Patent Application Serial No. 10/034,441, now issued as U.S. Patent No. 6,681,666. Applicant notes that the priority claim to 10/034,441 was first made in the Preliminary Amendment filed 30 July 2003, although that document refers to the wrong provisional application. However, this application as filed referred to the correct provisional application on the first page.

With this amendment, Applicant has provided a correct claim for priority, and respectfully requests withdrawal of the objection to the priority claim.

RESPONSE TO OFFICE ACTION
Attorney Docket No. 11009-22
Page 11 of 17

11009-22.JVD.319544

Double Patenting

Claims 10-23, 28, 29 and 33-36 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 9, 10, 11 of U.S. Patent No. 6,681,666. Applicant is providing a Terminal Disclaimer to overcome this rejection. The submittal of this Terminal Disclaimer shall not be regarded as an admission on the part of Applicant.

The rejections under 35 U.S.C. § 112.

Claims 30 and 37-40 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Claims 30 and 37 each include that the gripping elements are fabricated using one of the methods of electrical discharge machining, photo etching, and chemical etching. Support for these claims can be found on page 9 of the specification, lines 1-4. Applicant requests withdrawal of this rejection.

The rejections under 35 U.S.C. § 103.

Claims 20-40 were rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant admitted prior art (AAPA) in view of Smithwick et al. Applicant respectfully disagrees with these rejections.

The Office Action states that Smithwick teaches gripping means 200 that are sized and positioned so as to not completely pierce through a scrap portion, referring to FIGS. 1-10. In his disclosure, Smithwick states that element 200 comprises rubber ejectors disposed adjacent a

RESPONSE TO OFFICE ACTION
Attorney Docket No. 11009-22
Page 12 of 17

11009-22 JVD.319544

cutting rule (col. 3, lines 61-64). However, rubber ejectors are never disclosed as piercing the board. In contrast, the cutting rule structure penetrates the corrugated board 260, at which time the rubber ejector strips 200 simply start to compress, and are compressed between the die board and the corrugated board (col. 5, lines 14-19). In order to achieve this compression, Smithwick emphasizes the importance of designing the rubber ejectors to be sufficiently resilient (col. 5, lines 54-60). Applicant respectfully asserts that the rubber ejectors of Smithwick cannot be the means for gripping scrap portions as included in claim 20. Since all elements of claim 20 cannot be found in the cited combination, a *prima facie* case of obviousness has not been established.

In order to better clarify the invention, Applicant has amended claim 20 to include that the gripping means are sized and positioned so as to pierce through a first face of the moving web, but not to pierce through the second face of the moving web. Neither Smithwick nor any of the other cited references, alone or in combination, disclose the combination of elements of claim 20. Applicant respectfully requests withdrawal of the rejection of claim 20 and all claims dependent thereon.

With regards to claim 23, Applicant respectfully asserts that Smithwick does not disclose gripping means that are integrally formed with the rotary die. As discussed above, Smithwick discloses rubber, resilient ejectors. Applicant is unaware as to how such rubber ejectors could be integrally formed with the cutting material of a rotary die. Applicant respectfully requests citation of a reference to support the rejection.

With regards to claim 28, claim 28 includes a plurality of gripping elements extending from one of the cylinders. As discussed above, Smithwick discloses resilient rubber ejector elements, and not gripping elements. Since the cited combination does not include all elements

RESPONSE TO OFFICE ACTION
Attorney Docket No. 11009-22
Page 13 of 17

11009-22.JVD.319544

of claim 28, a *prima facie* case of obviousness has not been established, and Applicant respectfully requests withdrawal of the rejection of claim 28 and all claims dependent thereon.

With regards to claim 28, claim 28 includes a plurality of gripping elements each having a tip located from the center line of one cylinder by a distance less than the distance from the outer edge of a cutting element to the same center line. Applicant respectfully asserts that the cited combination does not include all elements of claim 28. Referring to claim 9 of Smithwick, it can be seen that the height of the rubber ejectors 200 are greater than the height of the cutting tip 232b of cutting rule 232. Therefore, the ejectors 200 of Smithwick extend a greater distance from the center line of the cylinder than the outer edge of the cutting elements. Lacking all elements of claim 28, the cited combination does not establish a *prima facie* case of obviousness, and Applicant respectfully requests withdrawal of the rejection of claim 28 and all claims dependent thereon.

With regards to claim 35, claim 35 includes a plurality of gripping elements that are integral with each other gripping element. As discussed above, Smithwick does not disclose gripping elements, but rather discloses resilient, rubber ejectors 200. Lacking all elements of claim 35, the cited combination does not establish a *prima facie* case of obviousness. Applicant respectfully requests withdrawal of the rejection of claim 35 and all claims dependent thereon.

Applicant has amended claim 35 to improve its clarity. Claim 35 includes gripping elements sized and positioned to partially pierce through the scrap portions. None of the cited references, either alone or in combination, disclose all elements of claim 35. Applicant respectfully requests allowance of claim 35 and all claims dependent thereon.

With regards to claim 22, claim 22 includes gripping means having a top surface that does not extend above the cutting elements. The Office Action states that the gripping means of

RESPONSE TO OFFICE ACTION
Attorney Docket No. 11009-22
Page 14 of 17

11009-22.JVD.319544

Smithwick have a top surface that does not extend above the cutting elements when it is compressed between two dies. As discussed earlier, Smithwick does not disclose elements that grip the scrap portions. Rather, Smithwick discloses resilient, rubber ejector elements that do not grip any scrap. Applicant respectfully requests withdrawal of the rejection of claim 22.

With regards to claims 24, 25, 31, 32, and 38, the Office Action states that the ejector elements 200 of Smithwick are at 3 points of an isosceles triangle, referring to FIGS. 5 and 11 of Smithwick. Applicant respectfully disagrees with this rejection. Applicant is unable to discern a pattern of isosceles triangle in either FIGS. 5 or 11. Applicant respectfully requests citation of a marked FIG. 5 or FIG 11 from Smithwick to show the isosceles triangular patterns. Applicant reserves the right to respond upon citation of a marked up, clarifying figure.

With regards to claims 26 and 33, the Office Action states that the modified apparatus of AAPA is capable of being used for web material of .01 inches thick with projections having a height of about .015 inches. Applicant respectfully disagrees with this rejection. The AAPA does not disclose the combination of elements of claims 26 and 33. Instead, this rejection appears to be based in impermissible hindsight. Applicant respectfully requests explanation of the motivation to modify the cited references, without using the Applicant's invention as that motivation. Applicant respectfully reserves the right to respond after this rejection is clarified.

With regards to claims 27, 34, and 40, these claims include that the gripping means includes a plurality of projections within a range of about 25 to about 400 projections per square inch. The Office Action states that Smithwick teaches varying the number of ejector elements 200 to accommodate die pressure, referring to FIGS. 5 and 11. Smithwick states that the "rubber ejector may be provided in various forms and sizes" (col. 4, lines 21-22). Applicant respectfully disagrees that Smithwick teaches the elements of claims 27, 34, or 40. Smithwick is altogether

11009-22.JVD.319544

silent as to specific dimensional characteristics of ejector strips 200. Applicant respectfully requests clarification of this rejection, and reserves the right to respond.

With regards to claim 39, Applicant agrees that Smithwick does not disclose the height of ejector elements 200. However, Applicant disagrees that it would have been obvious to one of ordinary skill to modify the ejector elements of Smithwick to have a height of about .015 inches. Smithwick discloses that his ejector elements need to be resilient. Referring to FIG. 7, it appears that Smithwick's ejector elements compress considerably more than fifteen thousandths of an inch. However, Smithwick does not disclose FIG. 7 to be a scaled drawing, nor does Smithwick disclose the specific limitations of claim 39. Applicant respectfully requests clarification and support for this rejection, and reserves the right to respond thereafter.

With regards to claims 30 and 37, the Office Action states that the AAPA teaches methods of fabricating gripping elements including masking or etching. Applicant respectfully disagrees with this rejection. The AAPA does not disclose the combination of elements of claims 30 and 37. Instead, this rejection appears to be based in impermissible hindsight. Applicant respectfully requests explanation of the motivation to modify the cited references, without using the Applicant's invention as that motivation. Applicant respectfully reserves the right to respond after this rejection is clarified.

New claims.

Applicant has added new claims 41-43 which depend upon independent claims 20, 28, and 35, respectively. These claims do not introduce new material. One example of support for these claims is found in claim 1 as originally filed.

11009-22.JVD.319544

CLOSING

Applicant has amended claims 20 and 35 and added new claims 41-43. Applicant respectfully request reconsideration of pending claims 20-43. The undersigned welcomes a telephonic interview with the Examiner, if the Examiner believes such an interview would facilitate resolution of any outstanding issues in this case.

Respectfully submitted

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11009-22.JVD.319544

RESPONSE TO OFFICE ACTION
Attorney Docket No. 11009-22
Page 17 of 17

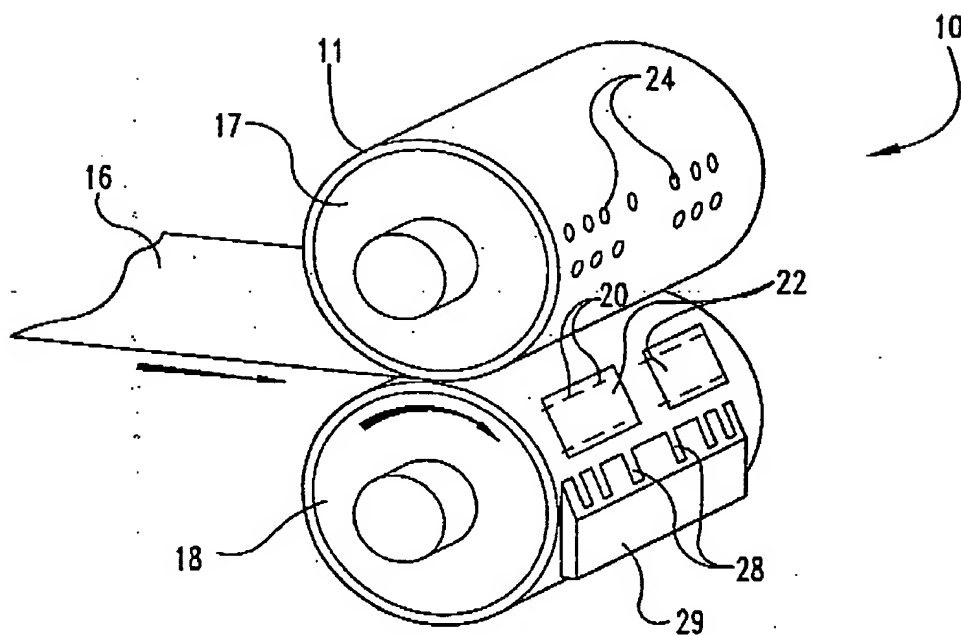


Fig. 1
(Prior Art)

U.S. Patent Application No. 10/630,342

Filed July 30, 2003

Inventor: Pfaff

Attorney: John V. Daniluck/ Docket 11009-22

Marked Up Page 2 of 4

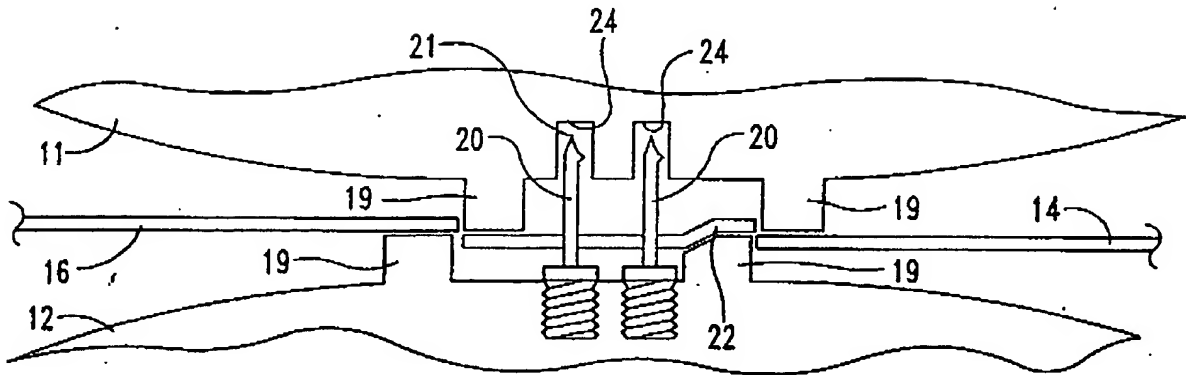
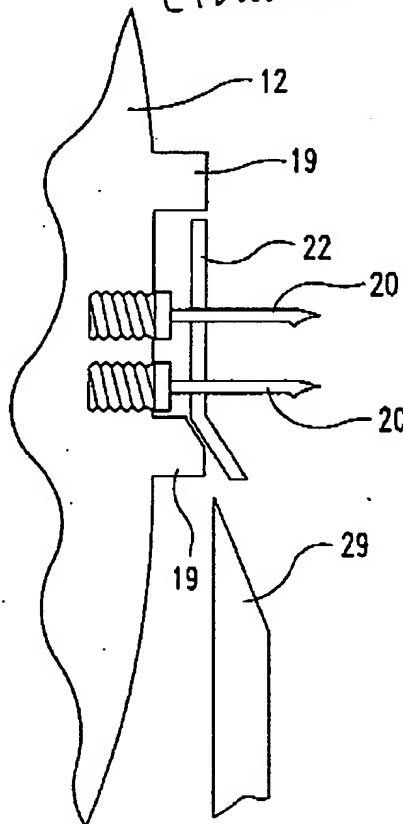


Fig. 2
(Prior Art)

Fig. 3
(Prior Art)



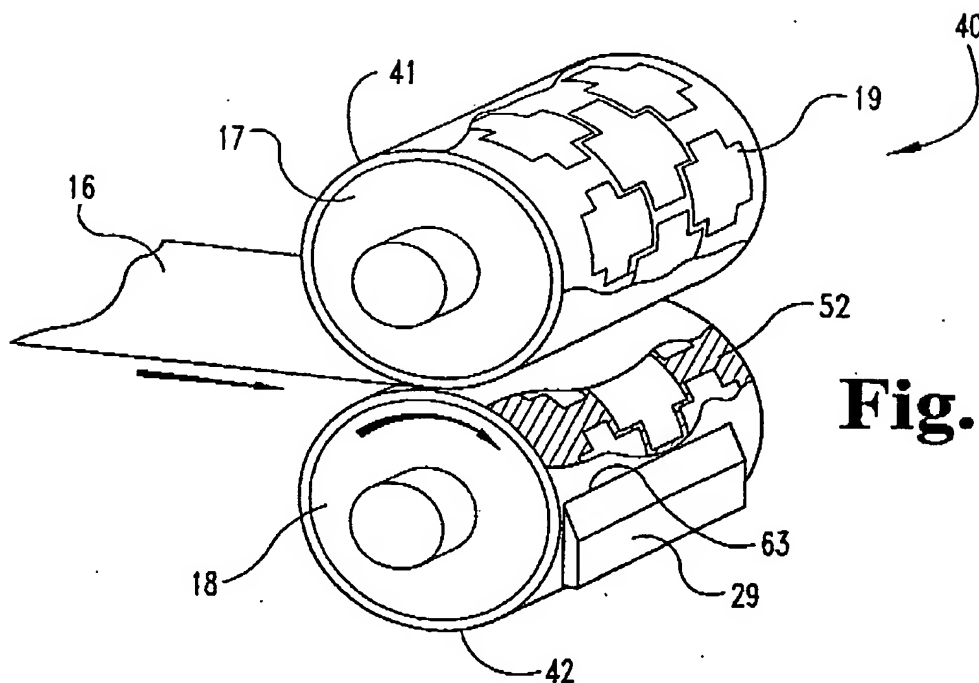


Fig. 6

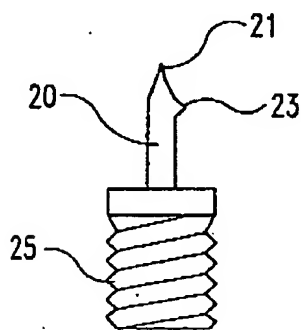


Fig. 4

(Prior Art)

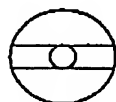


Fig. 5

(Prior Art)

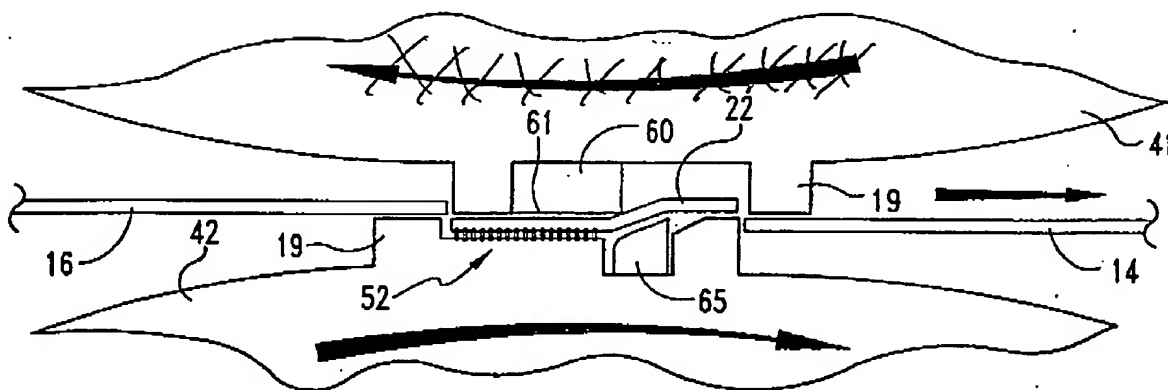


Fig. 8

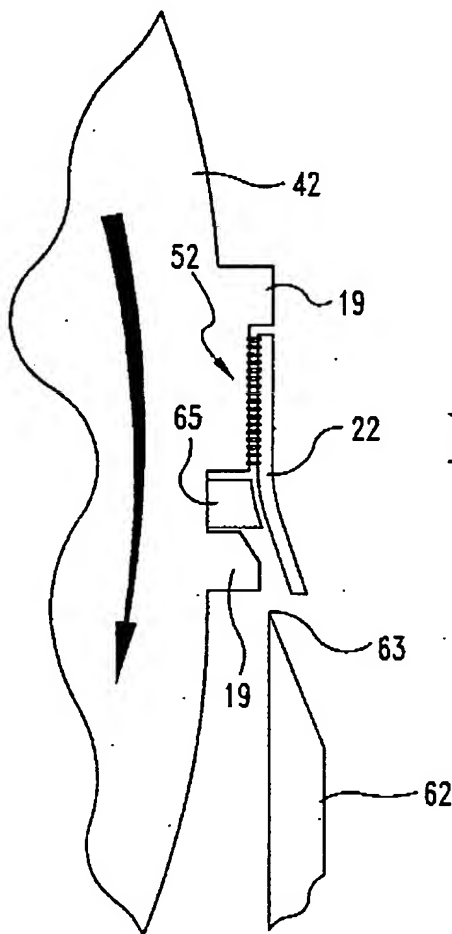


Fig. 9